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10/678,398	10/03/2003	Ralph Whitman	WHT.00001	3531

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EXAMINER	
SHOSHO, CALLIE E	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/678,398	WHITMAN, RALPH	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/27/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 4, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 2, which depends on claim 1, recites that the base oil includes at least one member selected from the group consisting of "mineral oil, with hydraulic oil, fatty acids, fatty oils, emu oil, fish oil, oleic acid and combinations thereof". The scope of the claim is confusing because it is not clear what is being claimed in light of the use of Markush language and the word "with". Does the base oil comprise mineral oil and hydraulic oil, fatty acids, fatty oils, emu oils, fish oil, or oleic acid or does the base oil comprise mineral oil and hydraulic oil or fatty acid or fatty oils or fish oil, etc.? What does the base oil encompass? Clarification is requested. Further, given that claim 1 requires base oil and at least one member selected from the group consisting of spearmint oil, peppermint oil, fatty acids, fatty oils, hydraulic oil and combinations thereof, it is not clear what, if any, difference there is between the fatty acids, fatty oils, and hydraulic oil of claim 1 and that required in the base oil of claim 2. Clarification is requested.

(b) Claim 19 requires composition comprising "mineral oil based ingredient or synthetic composition thereof", "spearmint oil or synthetic composition thereof", "peppermint oil or

synthetic composition thereof", "a dye, including a synthetic or organic composition thereof", etc. The scope of the claim is confusing because it is not clear what is meant by "synthetic composition or organic composition thereof" or what such composition encompasses. Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Neubauer (U.S. 6,039,937).

Neubauer discloses composition for use with razor wherein the composition comprises mineral oil, vegetable oil, rust inhibitor, and peppermint oil (col.1, lines 5-9 and 39-50, col.5, lines 39-55, and col.6, lines 8-10).

In light of the above, it is clear that Neubauer anticipates the present claims.

5. Claims 1-5 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Barcelon et al. (U.S. 4,853,247).

Barcelon et al. disclose composition comprising 90-99 wt.% mixtures of unpleasant oils including mixtures of mineral oil, vegetable oil, i.e. fatty oil, and fish oil and 0.1-10 wt.% mixtures of masking agents including peppermint oil and spearmint oil. It is disclosed that the peppermint oil and spearmint oil are used to mask odor and thus, it is clear that these oils function as fragrances. Further, given that the composition is an "edible" oil composition, it is clear that the mineral oil utilized must inherently be food grade (col.1, lines 7-10, col.1, line 60-col.2, line 5, col.3, lines 1-5, 9-19, 39-45, and 57-62, col.5, lines 56-57, and col.8, lines 53-56). It is noted that Barcelon et al. discloses the amount of mineral oil/fish oil and peppermint oil/spearmint oil in weight % while present claims 16-18 require volume %. However, given that the composition of Barcelon et al. comprises mainly mineral oil/fish oil, i.e. 90-99 wt.%, with small amount of peppermint oil/spearmint oil, i.e. 0.1-10%, as does the presently claimed composition and given that the ratio of mineral oil/fish oil to peppermint oil/spearmint oil in Barcelon et al. includes same ratio as the presently claimed components, i.e. ratio of mineral oil and fish oil to botanical oil, i.e. peppermint and/or spearmint, includes, for instance, about 9:1, it is clear that the amounts disclosed by Barcelon et al. inherently overlap those presently claimed.

It is noted that there is no disclosure in Barcelon et al. that the composition is "for use with cutting tools used for cutting hair" as required in all the present claims. However, the recitation in the claims that the composition is "suitable for" use with cutting tools used for cutting hair is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such

structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Barcelon et al. disclose composition identical to that presently claimed, it is clear that the composition would be capable of performing the intended use, i.e. for use with cutting tools used for cutting hair, presently claimed as required in the above cited portion of the MPEP.

In light of the above, it is clear that Barcelon et al. anticipate the present claims.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Weston (U.S. 4,963,351).

Weston discloses composition for use with shaver wherein the composition comprises emollient such as mineral oil and fatty oil such as soybean oil or coconut oil, dye, and fragrance (col.1, lines 5-9, col.4, lines 33-44, and col.4, line 67-col.5, line 8). Attention is drawn to example 5 that discloses composition comprising mineral oil, soybean oil, fragrance, and dye.

In light of the above, it is clear that Weston anticipates the present claims.

7. Claims 1-3 and 5 rejected under 35 U.S.C. 102(e) as being anticipated by Poisson et al. (U.S. 6,415,800).

Poisson et al. disclose composition for use with razor wherein the composition includes mineral oil, palmitic acid, i.e. fatty acid, and fragrance (col.1, lines 5-6, col.4, lines 35-40, and

Table 5).

In light of the above, it is clear that Poisson et al. anticipate the present claims.

8. Claims 1-3, 5-7, 11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Behan et al. (U.S. 5,334,581).

Behan et al. disclose composition comprising mineral oil, perfume, and dye wherein the perfume includes mixtures of peppermint oil and spearmint oil (col.1, lines 12-13, col.8, lines 37-54, and col.10, lines 40-45).

In light of the above, it is clear that Behan anticipate the present claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barcelon et al. (U.S. 4,853,247).

Barcelon et al. disclose composition comprising 90-99 wt.% mixtures of unpleasant oils including mixtures of mineral oil and fish oil and 0.1-10 wt.% mixtures of masking agents including peppermint oil and spearmint oil. It is disclosed that the peppermint oil and spearmint oil are used to mask odor and thus, it is clear that these oils function as fragrances. Further, given that the composition is an "edible" oil composition, it is clear that the mineral oil utilized must inherently be food grade (col.1, lines 7-10, col.1, line 60-col.2, line 5, col.3, lines 1-5, 9-19, 39-45, and 57-62, col.5, lines 56-57, and col.8, lines 53-56).

The difference between Barcelon et al. and the present claimed invention is (a) no explicit disclosure in Barcelon et al. of presently claimed composition and (b) no disclosure in Barcelon et al. that the composition is for use with cutting tools used for cutting hair.

With respect to difference (a), it is noted that col.8, lines 53-56 of Barcelon et al. disclose using mixtures of animal oil and mineral oil, col.3, lines 57-60 disclose that the animal oil includes fish oil, and col.3, lines 9-19 disclose that the masking agent includes peppermint oil and spearmint oil and that mixtures of masking agents are utilized. However, there is no explicit disclosure of using composition utilizing peppermint oil and spearmint oil as required in present claims 6-10.

However, while Barcelon et al. fail to exemplify the presently claimed composition nor can the claimed composition be "clearly envisaged" from Barcelon et al. as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the

claimed composition and the composition disclosed by Barcelon et al. as described above, absent a showing of criticality for the presently claimed composition, it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use composition which is both disclosed by Barcelon et al. and encompassed within the scope of the present claims an thereby arrive at the claimed invention.

With respect to difference (b), it is noted that there is no disclosure in Barcelon et al. that the composition is "for use with cutting tools used for cutting hair" as required in all the present claims. However, the recitation in the claims that the composition is "suitable for" use with cutting tools used for cutting hair is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Barcelon et al. disclose composition identical to that presently claimed, it is clear that the composition would be capable of performing the intended use, i.e. for use with cutting tools used for cutting hair, presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

11. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behan et al. (U.S. 5,334,581) in view of EP 654259.

The disclosure with respect to Behan et al. in paragraph 8 above is incorporated here by reference.

The difference between Behan et al. and the present claimed invention is the requirement in the claims of fatty acid.

EP 654259, which is drawn to hair conditioner composition as is Behan et al., disclose the use of fatty acid in order to provide hair with excellent pearl-like appearance (page 2, lines 3-5 and 33-37).

In light of the motivation for using fatty acid disclosed by Behan et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use fatty acid in the composition of Behan et al. in order to produce composition that results in excellent pearl-like appearance, and thereby arrive at the claimed invention.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wdowik et al. (U.S. 5,756,081) disclose shaving composition comprising fatty acid, mineral oil, and fragrance.

Hampton, Sr. (U.S. 5,147,575) disclose composition for cleaning razor that comprises mineral oil and fragrance.

Peele et al. (U.S. 6,792,960) disclose composition for cleaning razor that comprises mineral oil and scented material.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
1/21/06